

REMARKS

This reply is fully responsive to the Office Action dated August 21, 2008.

Disclosure/Claims Status Summary:

5 This application has been carefully reviewed in light of the Office Action of August 21, 2008, wherein:

- 10 A. Claims 1-2, 4-10, and 12-16 were rejected under 35 USC 102(e) as being anticipated by Copperman et al. (U.S. Patent No. 6,711,585 B1; henceforth referred to as the Copperman patent); and
- B. Claims 3, and 11 were rejected under 35 USC 103(a) as being unpatentable over the Copperman patent in view of Lang and M. Burnett. *Knowledge-Based Systems. XML, metadata and efficient knowledge discovery*. Pub. 2000. Elsevier Science B.V. (henceforth referred to as the Lang reference).

Claim Rejections - 35 USC § 102

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- A. **Claims 1-2, 4-10, and 12-16 are rejected under 35 USC § 102(e) as being anticipated by the Copperman patent**

20 The Examiner rejected Claims 1-2, 4-10, and 12-16 as being anticipated by the Copperman patent. In order to establish a prima facie case of anticipation, the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met.

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The Applicants assert that the Examiner has failed to establish a single reference that teaches or enables each of the elements of independent Claims 1 and 9, as currently amended. Specifically, the Applicants submit that the Copperman

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patent does NOT teach that the “first processing element is configured to convert electronic documents into PostScript files.”

The Applicants direct the Examiner to currently amended Claims 1 and 9, which
5 have been amended to further define the type of files being processed as PostScript files. It should be noted that the support for the amendment comes from Claims 2 and 10, as originally filed. Claims 2 and 10, as originally filed, defined the files as PostScript files. Thus, the limitation has now been amended into independent Claims 1 and 9, with Claims 2 and 10 being cancelled.

10 A PostScript file is an executable file that includes programming language for describing how a page is to be printed or displayed. PostScript files include functions for describing and positioning lines, shapes, fills, and other graphical elements for placing and formatting text. Thus, the present invention converts the
15 electronic document to an executable file (i.e., PostScript file) that is further processed.

Alternatively, the Copperman patent is limited to NON-executable files. As noted in Col. 12, lines 62-67 of the Copperman patent, the document is converted “into
20 a standard, simple format from which the simple, unformatted text of the document is easily extracted.” Thus, the first processing element in the Copperman patent converts the electronic document into a NON-executable file and, therefore, a NON-PostScript file.

25 For the reasons listed above, the Applicants believe that independent Claims 1 and 9 are now in allowable condition. Further, dependent Claims 4-8, and 12-16 are also allowable, at least based in part on their dependence upon allowable base Claims 1 and 9. Therefore, the Applicants respectfully request that the Examiner withdraw this rejection under 35 USC § 102(e) and provide for timely allowance
30 of Claims 1, 4-9, and 12-16.

Claim Rejections - 35 USC § 103**B. Claims 3 and 11 are rejected under 35 USC 103(a) as being unpatentable over the Copperman patent in view of the Lang reference**

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The Examiner rejected Claims 3 and 11 as being obvious in light of the Copperman patent in view of the Lang reference. Establishing a *prima facie* case of obviousness requires: (A) determining the scope and contents of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of

10 ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations. *See Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). Proper analysis of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. 35 U.S.C. 103(a).

Recently, the Supreme Court stated that “[R]ejections on obviousness cannot be sustained

15 by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007) quoting *In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

20 The Applicant believes that the Examiner has not set forth a *prima facie* case of obviousness because the Examiner has failed to establish references that, if combined or modified, teach each of the elements disclosed by Claims 3 and 11. The Applicants direct the Examiner to currently amended Claims 3 and 11, which have been amended to further define the spatial layout facts as “being augmented strings of text, where each

25 spatial layout fact contains a string of text and spatial data regarding the string of text.”

In reviewing the cited prior art, the Applicants have been unable to identify where it is taught that spatial layout data is strings of text with spatial data regarding the strings of text. The Applicants respectfully request that the Examiner point out, with specificity, where in the prior art the Examiner finds such a limitation. Failing that, the Applicants

30 respectfully submit that Claims 3 and 11, as currently amended, are allowable.

Furthermore, as noted above, the Applicants submit that Claims 1 and 9 are patentable. The Applicants submit that Claims 3 and 11 are also patentable over the cited art, at least based on their dependence upon an allowable base claims (Claims 1 and 9 respectively), and therefore respectfully request reconsideration and allowance of these claims.

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NEW CLAIMS 17-20

The Applicants direct the newly added Claims 17-20. Claims 17 and 19 are directed to further defining the spatial data while Claims 18 and 20 are directed to a specific set of rules for extracting the metadata from the PostScript files. The newly added claims include limitations that cannot be found in the cited prior art. Thus, in addition to their dependence upon allowable base Claims 1 and 9, the Applicants believe that Claims 17-20 are also allowable on their own merits. Thus, the Applicants respectfully request that the Examiner provide for timely allowance of Claims 17-20.

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CONCLUDING REMARKS:

The Applicants respectfully submit that, in light of the above amendments/remarks, the application and all pending claims are now in allowable condition. Therefore, reconsideration is respectfully requested. Accordingly, early allowance and issuance of
5 this application is respectfully requested.

Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather,
10 these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of
15 inventive concepts described in the application as originally filed.

Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicant's rights or in any way to create an estoppel preventing
20 Applicant from arguing allowability of the originally filed claim in further off-spring applications.

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant or Applicant's representative would be beneficial, the
25 Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not
30 timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of

the number of months necessary to make this response timely filed. The petition fee due in connection therewith may be charged to deposit account no. 50-2738 if a credit card form has not been included with this correspondence, or if the credit card could not be charged.

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Respectfully submitted,



10 Date

12/22/08

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